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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,426	01/14/2004	Tatsuya Tomioka	247527USOXDIV	6087
22850	7590	05/26/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			BUTTNER, DAVID J	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

CJ

<b>Office Action Summary</b>	<b>Application No.</b> 10/756,426	<b>Applicant(s)</b> TOMIOKA ET AL.	
	<b>Examiner</b> David Buttner	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 9-926828.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) ✓  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/14; 4/14; 4/29; 10/</u> | 6) <input type="checkbox"/> Other: ____  |

The lined out references on the 1449 form were mis-identified.

The list of related cases are not proper information disclosure statements because there is no column for the examiner's initials and no heading that clearly indicates the list is an IDS for any particular application number.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5,21-25,27-32 and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda '799.

Sakoda teaches polycarbonate substrates for optical discs (abstract). The polycarbonate has a Mv of about 14,300 and a Fe content of 0.2ppm or less (table 1). Fatty acid monoglycerides can be added at 0.005-0.1% (col 4 line 67). Sakoda does not report the free phenol content, but does teach washing the polycarbonate with acetone to remove unreacted components (col 3 line 36). This is the same technique applicant uses to remove excess free phenol (page 11 line 22 of spec). It would have been obvious to wash the polycarbonate to remove free phenol to any extent desired. Less free phenol would result in a purer product.

Claims 1-5,21-25,27-32 and 34 rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda '799 in view of Otsubo '896.

Sakoda does not teach to what degree the polycarbonate is washed to remove impurities and unreacted components.

Otsubo (abstract) teaches the acetone washing should extract enough bisphenol to leave less than 20ppm remaining. Such a high purity polycarbonate exhibits excellent performance as a optical disc substrate (col 1 line 44-46 of Otsubo).

It would have been obvious to extract enough phenol to leave less than 20ppm for the expected advantages.

Claims 1-5 and 21-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Sakoda '799 in view of Otsubo '896 in further view of Okamoto '653.

Sakoda suggests the inclusion of phosphorous antioxidants (col 3 line 44), but does teach particular amounts.

Okamoto (col 6 line 23; table 1) teaches typical amounts of phosphorous antioxidant in polycarbonate optical discs.

It would have been obvious to employ the conventional amounts of phosphorous antioxidant in Sakoda's disc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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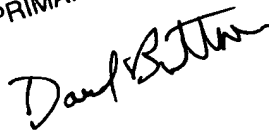
published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER  
David Buttner, PRIMARY EXAMINER

5/23/06

A handwritten signature in black ink, appearing to read "David Buttner", is written over the printed name and title.